

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action mailed December 23, 2009. Claims 1, 3, 4, 6-10, 12-15, 21, 22, and 26-29 remain pending, with claim 15 previously withdrawn from consideration. Claims 1, 3, 4, 6-10, 12-14, 21, 22, and 26-29 have been rejected. Applicants respectfully traverse all adverse assertions and rejections presented in the Office Action. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections - 35 USC § 103

Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Belef et al. (U.S. Patent No. 7,169,165) in view of Wholey et al. (U.S. Publication No. 2003/0176886). Applicants respectfully traverse the rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

The Examiner asserts that Belef et al. disclose “all elements of claim 23 except for additional aspiration ports being disposed distally of the aspiration port 16 and proximally of the distal end of the elongated shaft 10.” Wholey et al. are advanced as teaching “a similar filter delivery catheter (Figure 7) and...a plurality of ports 114 may be provided just proximal of the distal end of the catheter”. The Examiner then asserts that it would have been obvious to one of ordinary skill in the art to modify the apparatus of Belef et al. by providing “additional aspiration ports just proximal of the distal end of the delivery catheter”. Applicants respectfully disagree.

Initially, Applicants note that Belef et al. do not appear to disclose or suggest the limitation “wherein all of the aspiration ports are located proximally of the filtration device when the filtration device is entirely contained within the shaft lumen”. Figure 8-9 of Wholey et al. are disclosed as showing the withdrawal of filter assembly 140 into distal tip 104 of Figure 7. Filter 140 clearly appears to be too large to be entirely contained within the shaft lumen distally of all of the aspiration ports, as required by claim 23. Thus, Wholey et al. do not appear to disclose or suggest this claim limitation, either. Additionally, the proposed modification appears to further distinguish the claim,

since placing additional ports closer to the distal end will leave even less room for a filtration device to be entirely contained within the lumen distally of all of the aspiration ports. Therefore, the catheter of Belef et al., as modified by Wholey et al. in the manner proposed in the Office Action, does not appear to disclose or suggest that all of the aspiration ports are located proximally of the filtration device when the filtration device is entirely contained within the shaft lumen.

Accordingly, Belef et al. in view of Wholey et al. do not appear to disclose each and every element of independent claim 23, as is required to establish a *prima facie* rejection. Therefore, claim 23 is believed to be patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 1, 3, 4, 6-10, 12-14, 21, 22, and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Belef et al. in view of Wholey et al. as applied to claim 23 above, and further in view of Tao (U.S. Patent No. 6,610,005). After careful review, Applicants must respectfully traverse the rejection.

For reasons similar to the discussion above with respect to claim 23, Applicants submit that Belef et al. and Wholey et al. do not appear to disclose or suggest each and every element of independent claim 1. Additionally, the end caps of Tao appear to require inner catheter 25 pushing against end cap 32 to open the end cap. Neither Belef et al. nor Wholey et al. appear to provide a concentrically disposed internal catheter with a domed end cap 44 for opening the proposed end cap. Belef et al. and Wholey et al. appear to disclose a support or guide wire for an embolic protection device, and the support or guide wire does not appear to be disclosed as having a domed end cap or as being capable of pushing open the proposed end cap. Without opening the end cap, the filter cannot be deployed. Therefore, the proposed modification appears to render the device unsuitable for its intended purpose (MPEP 2143.01 V). Furthermore, a closed end cap on the catheter of Belef et al. as modified by Wholey et al. would appear to render it inoperable as a rapid exchange catheter, which requires a guidewire to enter the distal end in order to lead the catheter to the desired location within the vasculature. Tao also discloses that the catheter end caps are used to prevent the accumulation of mucous within the catheter during insertion through the cervix. The devices of Belef et al. and

Wholey et al. do not appear to be used in this portion of the anatomy, nor is mucous expected to be present within the vasculature. For at least these reasons, the combination of Tao with Belef et al. and Wholey et al. appears to be improper.

Since Belef et al. and Wholey et al., with or without the benefit of Tao, do not appear to properly disclose or suggest each and every element of independent claim 1, as is required to establish a *prima facie* rejection, independent claim 1 is believed to be patentable over Belef et al., Wholey et al., and Tao. Since claims 3, 4, 6-10, 12-14, 21, 22, and 26 depend therefrom and add additional elements thereto, Applicants submit that claims 3, 4, 6-10, 12-14, 21, 22, and 26 are also patentable over the cited references and respectfully request that the Examiner withdraw the rejection.

Claims 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Belef et al. in view of Wholey et al. and Tao as applied to claim 1 above, and further in view of Hoy (U.S. Patent No. 6,705,575). After careful review, Applicants must respectfully traverse the rejection.

As discussed above, independent claim 1 is believed to be patentable over Belef et al., Wholey et al., and Tao. Hoy does not appear to remedy the shortcomings of Belef et al., Wholey et al., and Tao with respect to claim 1. Therefore, claim 1 is believed to be patentable over the cited combination. Since claims 27-29 depend therefrom and add additional elements thereto, Applicants submit that claims 27-29 are also patentable over the cited references and respectfully request that the Examiner withdraw the rejection.

Conclusion

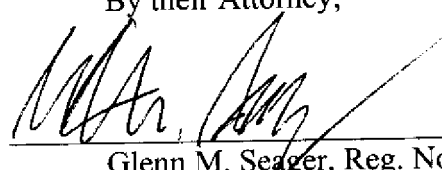
In view of the foregoing, all currently pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

ROBERT M. RAUKER et al.

By their Attorney,

Date: March 15, 2010



Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050